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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/785,775	02/20/2001	Pankaj B. Patel		3411
7590	03/01/2011		EXAMINER	
PANDISCIO & PANDISCIO 470 TOTTEN POND ROAD WALTHAM, MA 02451-1914			TERRELL, EMILY C	
			ART UNIT	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	09/785,775	PATEL, PANKAJ B.	
	Examiner	Art Unit	
	EMILY TERRELL	2612	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 20 February 2001.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-4 is/are rejected.
- 7) Claim(s) 2-4 is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ . |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>September 22, 2005</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| | 6) <input type="checkbox"/> Other: _____ . |

DETAILED ACTION

Claim Status

1. Claims 1-4 are pending for examination. Additionally, item (f) in claim 1 is of the means plus function structure, therefore, said item (f) will be interpreted according to 35 U.S.C. §112, ¶6 requirements.

Information Disclosure Statement

2. The information disclosure statement (IDS) submitted on September 22, 2005 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Objections to Drawings

3. The drawings are objected to because:

Element 5, "finger 5," needs to be clearly referenced when disclosing Figures 2-5, and 7. Figure 5, element 19 is either misnumbered and should be finger print 20, or clarification in the disclosure needs to be provided.

In Figures 9, 10, and 15, element 19 is inconsistent with the prior figures.

Additionally, the "button" needs to be clearly identified within the drawings with an element number.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet,

even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Objections to Specification

4. The disclosure is objected to because of the following informalities:

The explanation of Figures 12-13 in the disclosure needs to include element numbers when referencing finger, "ex. finger 5."

Element 9, "reader" as disclosed in Figures 2, 3, 4, 5, 6, 7, 8, 9, 10, 14, and 15 is confusing, as element 2 is also disclosed as "reader". Examiner respectfully suggests that Applicant label element 9 as "sensor" to provide clarity.

Appropriate correction is required.

Claim Objections

5. Claims 2-4 are being objected to because of the following informalities:

For Claim 2, "A" should be changed to "The," and "a" should be "apparatus," "A(The) fingerprint reading ~~a(apparatus)~~ set forth in claim 1 wherein said power supply is a miniature battery encased in said button."

For Claim 3, "A" should be changed to "The," "a" should be "apparatus," and "is" needs to be added after the processor, "A(The) fingerprint reading ~~a(apparatus)~~ set forth in claim 1 wherein said processor is communicating with a remote processor and memory storage."

"A(The) fingerprint reading ~~a(apparatus)~~ set forth in claim 3 wherein said communicating between said processor and said remote processor is wireless."

Appropriate correction is required.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1, 3, and 4 are being rejected under 35 U.S.C. 103(a) as being unpatentable over

Hsu et al (Hsu; U.S. Patent 6,041,410) and **Houdeau** (U.S. Patent 6,522,773 B1).

For Claim 1, Hsu discloses the finger print reading apparatus for reading finger prints and giving tactile feedback, said apparatus comprising:

- a. a button having an upper surface, said button affixed to a housing (Fob 14, user interface 38),
- b. a finger print reader affixed to said upper surface of said button (Fingerprint sensor 16),
- c. a processor communicating with said finger print reader (Processor module 20),
- d. a power supply electrically connected to said processor (Battery power supply 24),
- e. a memory storage communicating with said processor (Storage 32, storage 36),

Hsu does not explicitly state that the disclosed button has a means for

electromechanically allowing the button to slide within the housing, however, the button disclosed by Hsu does communicate with the processor via the power supply (Figures 1-3; Column 4 lines 40-46, 57-67, and column 5 lines 1-47).

Houdeau teaches allowing a pushbutton button to slide:

f. a means for electromechanically allowing said button to slide within said housing, said means communicating with said processor, said means powered by said power supply (Figures 1-3; Column 1 lines 61-67, column 2 lines 1-5, and column 3 lines 1-43).

Allowing a button to communicate with a processor through the ability to selectively contact saves energy, and makes the finger print reading process more definitive. Incorporating the button assembly as taught by Houdeau into the system of Hsu renders the functionality of the present invention as claimed. Therefore, it would have been obvious to one of ordinary skill in the art at the time that the invention was made to incorporate the button of Houdeau into the system of Hsu to allow for economy of energy.

For Claim 3, Hsu further discloses the fingerprint reading apparatus set forth in claim 1 wherein said processor is communicating with a remote processor and memory storage (Receiver 15, Wireless transceiver 22; Figures 1 and 4; Column 2 lines 15-36, column 6 lines 25-67, and column 7 lines 1-34).

For Claim 4, Hsu further discloses the fingerprint reading apparatus set forth in claim 3 wherein said communicating between said processor and said remote processor is wireless (Figures 1 and 4; Receiver 15, Wireless transceiver 22; Column 2 lines 15-36, column 6 lines 25-67, and column 7 lines 1-34).

7. Claim 2 is being rejected under 35 U.S.C. 103(a) as being unpatentable over **Hsu** in view of **Houdeau**, and further in view of **Gupta et al.** (Gupta; U.S. Patent 7,239,227 B1).

For Claim 2, Hsu does not explicitly disclose the battery encased inside of the button; rather; Hsu discloses a battery enclosed in the personal Fob, where the battery powers the fingerprint sensor, wireless transceiver, and the button (Fob 14, battery power supply 24; Column 5 lines 1-15).

Gupta teaches the fingerprint reading apparatus set forth in claim 1 wherein said power supply is a miniature battery encased in said button (Figure 4; Column 3 lines 44-63, column 6 lines 62-67, and column 7 lines 1-16, 30-41). Selectively drawing power from the battery encased in the transmitting device allows for economy of energy, and longer lasting functionality of the fingerprint reading apparatus. Placement of a battery inside of the button is not an inventive concept; rather, the configuration of components does not constitute a patentable feature as placement of a battery is irrelevant, the functionality of the battery is the same

regardless of location. Additionally, due to the nature of the fingerprint sensing device it is known in the art to provide the battery within the sensor structure. Therefore, it would have been obvious to one of ordinary skill in the art at the time that the invention was made to connect selectively connect a battery for economy of energy.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

Anazi et. al disclosed a Keyless User Identification and Authorization System for a Motor Vehicle (U.S. Patent 6,271,745 B1),

Novikov et al. disclosed a Biometric System for Biometric Input, Comparison, Authentication and Access Control and Method Therefor (U.S. Patent 6,282,304 B1),

Fishbine el al. disclosed Portable Fingerprint Scanning Apparatus for Identification Verification (U.S. Patent 5,467,403),

McClurg et al. disclosed Hand-held Fingerprint Scanner with On-Board Image Normalization Data Storage (U.S. Patent 6,744,910 B1),

Kramer disclosed a Capacitive Semiconductor User Input Device (U.S. 6,408,087 B1).

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to EMILY TERRELL whose telephone number is (571)270-3717. The examiner can normally be reached on Monday-Thursday 8-4 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

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supervisor, Daniel Wu can be reached on (571)272-2964. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Emily Terrell/
Patent Examiner, Art Unit 2612

/Daniel Wu/
Supervisory Patent Examiner, Art Unit 2612